

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/314,738 05/19/99 ROSEN S 0225-4185

MORGAN & FINNEGAN LLP
345 PARK AVENUE
NEW YORK NY 10154

WM31/0920

EXAMINER

BARRON JR, G

ART UNIT	PAPER NUMBER
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2132

DATE MAILED:

09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/314,738	ROSEN, SHOLOM S.	
	Examiner Gilberto Barrón Jr.	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 July 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Request for Reconsideration

1. The request for reconsideration has been carefully considered, but is not persuasive in overcoming the rejection for lack of an adequate written description of the invention. The statement of rejection followed by a response to Applicant's arguments is presented below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-11 have been presented as corresponding to claims 1-5, 12, and 15-18 of the Hiroya et al patent (5754,654). However, The instant written description does not provide support for all the elements of the claims.

In particular, the electronic ticket storage device of claims 1, 6, and 11 does not have support in the written description as recited in the claims. The limitations of the claims recite that the electronic ticket storage device stores electronic money, an electronic ticket, and a transaction history including transactions of electronic money and electronic tickets, and where said transaction history is updated, by a program

stored in said electronic ticket storage device, after a transfer of either electronic money or an electronic ticket.

The disclosure of the instant application is directed to a transaction device comprising a trusted agent and a money module. This arrangement for separate trusted agent and money module components, is in keeping with the objectives of the instant application for a flexible, anonymous and trusted electronic system, see Summary of the Invention.

It is not established how the proposed claims, which set forth an invention that teaches away from separate components, could be supported by a disclosure that describes an invention having separate components, and the benefits and uses of the invention that is comprised of the separate components. Part of Applicant's Request for Interference, references that the functions of the money module are supported by an earlier application, separate from the instant application, describing the money module as a completely separate component.

The claimed electronic ticket storage means further requires an update feature and a transaction log history having the information for both electronic money and electronic tickets. The instant disclosure appears to disclose separate transaction history logs and a different update function in keeping with the nature of the separate components of trusted agent and money module.

In addition to the lack of support for the electronic ticket storage device, claims 6-10 recite steps of sending, receiving, and recording of electronic tickets and money. However, these steps are not supported by the instant disclosure. The disclosure of the

instant application appear to disclose sending and receiving tickets through the trusted agents, first, and then the sending and receiving of the electronic money, second. Further, the recording step is not disclosed. The instant disclosure does establish a commit function, but this does not appear as a recording step as necessitated by the claims.

Response to Arguments

4. Applicant's arguments are not persuasive. The portion of the specification pointed to as describing money module and trusted agent fabricated as a single tamper proof module does not provide a written description for the claimed invention of a electronic ticket storage means or device that stores electronic money, electronic ticket(s) and a transaction history. Applicant's specification describes an invention that provides for separate storage of electronic money, electronic ticket(s) and separate transaction histories for each. The written description describes separate communications between money modules and trusted agents. The description indicates that a fabrication of trusted agent and money module as a single tamper proof module would eliminate the requirement for secure communications between a money module and a trusted agent, but still describes the separate communications between money modules from customer to merchant, and trusted agents from merchant to customer, and separate transaction histories for each. Further, the description of the invention indicates that transaction device, Figure 3, #122, includes three components, host processor, 124, trusted agent 120 and money module 6. While the invention of the claims requires a terminal means separate from the electronic ticket storage means.

Applicant's specification does not support a terminal means separate from the electronic ticket storage means.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Mr. Albert Decady, can be reached on (703) 305-9595, or Ms. Gail Hayes, can be reached on (703) 305-9711.

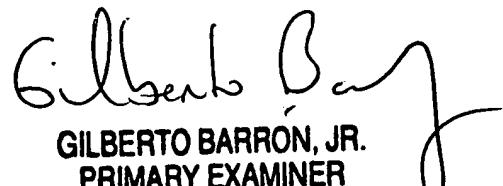
The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

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The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


GILBERTO BARRÓN, JR.
PRIMARY EXAMINER
ART UNIT ~~200~~ 2132